

REMARKS

Claims 1-13, 19-26, 28-31, 33 and 34 are presented for examination in this application, of which Claims 1, 4, 19, 23, 25, 26, 28-31, 33 and 34 are in independent form. Claims 14-18, 27 and 32 have been withdrawn from consideration.^{1/} Claims 1-12, 19, 21, 23, 25, 26, 28-31, 33 and 34 have been amended to define still more clearly what Applicants regard as their invention. It should be noted that none of the claim amendments are intended or believed to narrow the scope of any claim recitation.

Applicants note the objection to Claims 1, 4, 6 and 7 due to typographical informalities and non-U.S. spelling. The errors have been corrected, and U.S. spelling has been adopted throughout the claims under examination.

Claim 3 was rejected under 35 U.S.C. § 112, second paragraph, as being indefinite. That claim has been amended to delete the portions that formed the basis for the rejection, withdrawal of which is therefore respectfully requested.

Claims 19-22 and 29-32 were rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent 5,499,366 (Rosenberg). Claims 1-13, 25, 26 and 31 were rejected under 35 U.S.C. § 103(a) as being unpatentable over *Rosenberg*, in view of U.S. Patent 6,324,545 B1 (Morag); Claims 23, 29 and 34 were rejected as being unpatentable

^{1/} The Office Action Summary indicates that Claims 14-18, 28 and 33 are withdrawn from consideration. Also, Applicants note that in paragraph 4 of the Detailed Action, Claims 28 and 33 are listed as falling in both Group I and Group II of the claims. The claims directed to automatically selecting a theme from a collection of themes (i.e., Group II) are Claims 14-18, 27 and 32, and these are the non-elected claims.

over *Rosenberg*, in view of U.S. Patent 5,787,254 (Maddalozzo, Jr. et al.); and Claim 24 was rejected as being unpatentable over *Rosenberg*, in view of *Maddalozzo* and *Morag*.

Applicants note that Claim 19 is a method claim from which Claims 20 - 22 depend. Claim 28 is an apparatus claim corresponding to the method of Claim 19, and Claim 33 is a computer program product claim corresponding to the method of Claim 19. Claim 29 is an apparatus claim corresponding to the method of Claim 23, and Claim 32 has been withdrawn. Accordingly, Applicant understands that the rejection under 35 U.S.C. § 102(b) applies to Claims 19-22, 28 and 33 rather than to Claims 19-22 and 29-32.

The Anticipation Rejection

Independent Claim 19 is directed to a method of automatically selecting a font from a collection of fonts for use in one or more texts. The method automatically selects one or more fonts from the collection of fonts, based on information associated with the one or more texts. The method sets the font of the one or more texts to one of the selected fonts.

Rosenberg relates to an expert system for suggesting and providing graphic design selections based on a user's desired results. The expert system provides a plurality of descriptors to define the characteristics of an output page or document. A user can weight the descriptors, as desired, and the expert system utilises the weighted descriptors to select a number of solutions from a predefined database of possible solutions (see Abstract).

The expert system of *Rosenberg* uses an intelligent search that involves rejection constraints (which are binary and must be met) and so-called fuzzy constraints,

which are statistical in nature. In the intelligent search, each solution is first checked against the rejection criteria via a simple pattern match algorithm, to reduce the set of acceptable solutions. Those solutions which pass the first rejection criteria are further analyzed to determine those that lie closest to a hypothetical vector that describes the user input (see col. 4, lines 19 - 28).

Importantly, the selection made by the expert system of *Rosenberg* depends on inputs provided by a user rather than on information associated with the text to which the selected front is applied. For example, Fig. 4 of *Rosenberg* and the associated text at col. 11, lines 39 - 57, describe how a user may specify characteristics of a font. The user is presented with three sliding scales. The first scale defines a range between informal and formal. The second scale defines a range from contemporary to traditional and the third scale defines a range from simple to fancy. The user also indicates whether the fonts are intended for use as headline, body or foot note text. Once the user has made selections on the scales 401A - 401C, the user activates the "advise" button 405 to initiate the search. After the search is completed, the names of fonts that are potential solutions are identified. The user may select a suggested font solution by activating the "apply" button in region 406. The expert system of *Rosenberg* is thus based on parameters provided by a user. The expert system allows the user to choose a page layout and font. Thus, the information on which the selection is based is not associated with the text to which the selected font is applied.

This is not believed to teach or suggest the method of Claim 19, in which a font is automatically selected for use in one or more texts, based on information associated with the one or more texts.

Moreover, Applicants submit that *Rosenberg* has a different purpose to the method of Claim 19. *Rosenberg* provides an expert system for suggesting a desired graphic design solution based on a desired result achieved by a user manipulating a set of controls. The level of user manipulation or intervention is contrary to the spirit of the method of Claim 19, where the automatic selection is intended to minimize or eliminate entirely this user intervention.

Applicants therefore submit Claim 19 is allowable over *Rosenberg*.

Claims 28 and 33 are, respectively, an apparatus and a computer program product claim corresponding to the method of Claim 19. It is submitted that Claims 28 and 33 are patentable in light of *Rosenberg* for at least the reasons discussed above with respect to Claim 19.

The Obviousness Rejections

Independent Claim 1 is directed to a method of automatically selecting a font from a collection of fonts for use in one or more captions associated with one or more images. The method automatically selects one or more fonts from the collection of fonts, based on information provided with the one or more images. The font of the one or more captions is set to one of the selected fonts.

The Office Action cites *Rosenberg* as teaching the recited steps of “automatically selecting one or more fonts from said collections of fonts, based on

information provided with one or more text in output pages or documents". Applicant disagrees with this assertion. As discussed above, *Rosenberg* does not select fonts based on information provided with text in output pages or documents. Instead, *Rosenberg* selects graphic design features based on parameters (rejection constraints and fuzzy constraints) provided by a user. The method of *Rosenberg* makes no reference to the text to which the graphic design is ultimately applied.

On page 8, the Office Action concedes that *Rosenberg* does not explicitly disclose that fonts are selected based on information provided with one or more images. However, the Office Action asserts that *Morag* teaches automatically selecting themes based on information associated with one or more images.

Morag relates to a method of generating a personalized photo album. As described at col. 1, lines 52 - 63, a customer acquires digital images and transmits the images to a service provider. The service provider arranges the images into an album format, prints out the images, assembles the album and mails the album to the customer. The user may provide instructions for the service provider to use in making the album arrangements. Such instructions are described at col. 7, lines 28-53. Instructions may include label instructions which associate text and/or graphic labels with each image and/or group of images, as described further at col. 9, lines 30-44. The instructions may include the formatting of the labels, such as size, cover and font. Thus, the instructions may specify a font for use in labels. However, there is no teaching or suggestion in *Morag* of automatically selecting one or more fonts from a collection of fonts. Applicant submits that

any hypothetical combination of *Rosenberg* and *Morag*, even assuming such combination would even be permissible, would not teach or suggest all the recitations of Claim 1.

In view of the foregoing, it is submitted that Claim 1 is patentable over *Rosenberg* and *Morag*.

Independent Claims 25 and 30 are, respectively, an apparatus and computer program product claim corresponding to the method of Claim 1. For at least the reasons given with respect to Claim 1, it is submitted that Claims 25 and 30 are patentable over *Rosenberg* and *Morag*.

Independent Claim 4 is directed to a method of automatically selecting a font from a collection of fonts for use in one or more captions associated with one or more images. The method analyzes meta-data associated with the one or more images to determine a key feature among the meta-data. The method searches a library of fonts, each font having a set of one or more associated key features, and automatically selects one or more fonts from the font library having an associated key feature that best matches the key feature determined in the analyzing step. The method sets a font of the one or more captions to one of the selected one or more fonts.

The Office Action, on page 9, asserts that *Rosenberg* teaches the step of analyzing meta-data associated with one or more text documents to determine a key feature amongst the meta-data. The Office Action refers specifically to *Rosenberg's* analyzing scale values to select an appropriate font for suggestion. However, as discussed above, the method of *Rosenberg* does not analyze meta-data associated with a text document. Instead, the search of *Rosenberg* is based on graphic design parameters provided by a user.

Furthermore, as discussed above, *Morag* is entirely silent on searching a library of fonts, each font having a set of one or more associated key features and automatically selecting one or more fonts from the font library having an associated key feature best matching the determined key feature.

Applicants therefore submit that, without the benefit of impermissible hindsight afforded by Applicants' own disclosure, any hypothetical combination of *Rosenberg* and *Morag* does not teach or suggest all the recitations of Claim 4. Claim 4 is thus believed patentable over *Rosenberg* and *Morag*.

Apparatus Claim 26 and computer program product Claim 31 are believed patentable over *Rosenberg* and *Morag* for at least the reasons discussed above with respect to Claim 4.

Independent Claim 23 is directed to a method of automatically selecting a font from a collection of fonts for use in one or more hyperlink texts, in which the one or more texts are in an initial font. The method automatically selects one font from the collection of fonts, based on information associated with the one or more hyperlink texts. The method replaces the initial font of the one or more hyperlink texts with the selected font.

On page 15, the Office Action asserts that *Rosenberg* teaches "automatically selecting one or more fonts from said collections of fonts, based on information associated with one or more texts". As discussed above, Applicants disagree with this interpretation of *Rosenberg* and submits that the selection in *Rosenberg* is based on parameters provided

by a user. The selection in *Rosenberg* is thus independent of the text to which the selected font is applied.

Maddalozzo relates to a system for a web browser having as objects the provision of improved information retrieval methods. A client has an interface for displaying a first hypertext document with one or more hypertext links to a second hypertext document located at a server. The method of *Maddalozzo* tags latency and time period metrics with a URL address link (step 131). The latency and time period metrics are provided to a user, providing the user with an estimation of the length of time to access a server. With such information available, the user can make a decision whether to continue invoking a particular link or to terminate the linking process (col. 3, lines 31-34).

In *Maddalozzo*, latency time for each link can be implemented by highlighting, colouring, or changing the font of the link text (col. 10, lines 50-51). With this system, all highlighted link text can indicate to a user that activating that particular link with a cursor pointer will result in a lengthy latency time period. Link text which is not highlighted will have a shorter latency time period (col. 10, lines 63-67).

Applicants submit that nothing has been found in *Maddalozzo* of replacing an initial font of one or more hyperlink texts with a font that is automatically selected from a collection of fonts, based on information associated with the one or more hyperlink texts.

Accordingly, even a hypothetical combination of *Maddalozzo* and *Rosenberg*, assuming that such combination would even be a permissible one, would not teach or suggest all the recitations of Claim 23. Claim 23 is therefore believed patentable over *Rosenberg* and *Maddalozzo*.

Claims 29 and 34 are, respectively, apparatus and computer program product claims corresponding to the method of Claim 23. These claims, together with dependent Claim 24, are believed patentable over *Rosenberg* and *Maddalozzo* for at least the reasons given above with respect to method Claim 23.

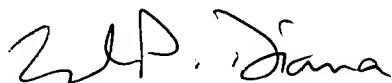
A review of the other art of record has failed to reveal anything which, in Applicants' opinion, would remedy the deficiencies of the art discussed above, as references against the independent claims herein. Those claims are therefore believed patentable over the art of record.

The other claims in this application are each dependent from one or another of the independent claims discussed above and are therefore believed patentable for the same reasons. Since each dependent claim is also deemed to define an additional aspect of the invention, however, the individual reconsideration of the patentability of each on its own merits is respectfully requested.

In view of the foregoing remarks, Applicants respectfully request favorable reconsideration and early passage to issue of the present application.

Applicants' undersigned attorney may be reached in our New York office by telephone at (212) 218-2100. All correspondence should continue to be directed to our below listed address.

Respectfully submitted,



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